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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,366	01/28/2002	Toshihiko Muramatsu	PW 0277035 H7609US	5213
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PILLSBURY WINTHROP SHAW PITTMAN LLP 725 S. FIGUEROA STREET SUITE 2800 LOS ANGELES, CA 90017				
			EXAMINER NGUYEN, BINH AN DUC	
			ART UNIT 3713	PAPER NUMBER

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,366

Applicant(s)

MURAMATSU, TOSHIHIKO

Examiner

Binh-An D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The Amendment filed March 7, 2005 has been received. According to the Amendment, the specification and claims 1, 15, and 19 have been amended. Currently, claims 1-23 are pending in the application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13, 15, and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Wade et al. (US 2002/0165764).

Referring to claims 1-3, 15 and 17, Wade et al. teaches a game playing system and method comprising: a game device (16, 20, 24) for allowing a player to play a prescribed game; a management server (28) for connecting the game device via a network and for managing the game device via the network; and a shop server (32) for providing commodities or services via the network, wherein the management server automatically provides the game device with different location information specifying the shop servers in response to different scores (i.e., netstamps or points) of the prescribed

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game notified thereto from the game device (Fig.7), so that the player is allowed to select a desired commodity or service described on a homepage of the shop server specified by the location information based on the score of the prescribed game (paragraphs 24-33 and Figs. 2, 5A, 4, 7, and 9); the management server provides the game device with location information, having different sites, describing a plurality of shop servers (advertisers: retailer, wholesaler or manufacturer)(paragraph 24) that deal with different kinds of commodities or services respectively in response to the score of the prescribed game, so that the player of the game device is allowed to select a desired shop server whose location information is described on the location information list)(paragraphs 27 and 28). Note that, the win play points and net stamps teaches by Wade et al. are equivalent to the applicant's game scores.

Referring to claims 4-13, 18, and 19, Wade et al. teaches the management server automatically provides the player of the game device with the desired commodity or service as a prize based on the score of the prescribed game without charging its cost to the player (reward user coupons for using the system (paragraph 32)); the management server automatically provides the player of the game device with the desired commodity or service (tagged product) as a prize based on the score of the prescribed game while sharing at least a part of a cost of the desired commodity or service within a prescribed privilege granted for the player in advance (paragraph 35); automatically providing the player with the desired prize based on the score of the prescribed game (paragraph 25); wherein the game device is installed in a home (home PC); wherein the information providing site is a shopping site whose homepage can be

read by prescribed browser software; wherein the game device comprises a game provider for providing the prescribed game, a transmitter (computer modem) for transmitting the score of the prescribed game to the management server, and a receiver (computer modem) for receiving location information specifying the information providing site for providing the prize information online (paragraphs 8-10); the game device further comprises a reader (display) for allowing the player to read a homepage of the information providing site specified by the location information provided from the management server, and a selector for allowing the player to select a desired prize on the homepage (website) of the information providing different sites (paragraphs 25 and 26). See also Figs. 1, 3, 5B, 6, 8, and 10; and paragraphs 34-40.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14, 16, and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wade et al. (US 2002/0165764) in view of Bougaki Tetsuya (Publication No. 10-151266 or Japanese Patent No. JP410151266A).

Wade et al. teaches all limitations of claims 1-13, 15, and 17-19 above. Wade et al. further teaches a game playing system and method wherein the player uses a card (smart card 26) for payment required for game (paragraphs 32 and 34); and the player

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enters information allowing the shop server to provide a prize for a consideration of the score of the game; enters information allowing the shop server to provide a prize for a consideration of the score of the pachinko game (providing play points)(paragraphs 26-27). Wade et al. does not explicitly teach the limitations of the prescribed game is a pachinko game (claims 14, 16, 20, 21, and 23); a card having monetary value for playing the pachinko game (claim 22). Tetsuya, however teaches a gaming network comprising pachinko game machines which utilized monetary value of member cards for playing the pachinko game (see Detailed Description, paragraphs 1, 3, and 15-36).

Note that the limitation of fame score is counted as a multiple of the number of balls that fall into a prescribed hole on a board (claim 16); a prescribed number of balls are distributed for the player to start a pachinko game and are sequentially shot onto a board, (claim 20); big hit providing the player with a special chance to gain a greater number of balls (claim 21) are inherently known from the pachinko or vertical pinball games.

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made combine Wade et al.'s game playing system and method with the pachinko gaming network, as taught by Tetsuya, to provide convenience in managing game account expense.

Response to Arguments

Applicant's arguments filed March 7, 2005 have been fully considered but they are not persuasive.

The applicant argued that in Wade et al. does not provide information in response to different scores of the prescribed network (applicant's remarks, page 10, last paragraph bridging page 11). The Examiner respectfully disagreed. The game playing system and method of Wade provides the game players or members a list or catalog of different merchandises from different advertisers so that the players or members can exchange different points (game points, credits, netstamps or coupons) for different types or merchandises. Note that, different players would have different points or credits to exchange for the merchandise. Further, the applicant's specification also discloses that the list of merchandise having monetary information representing upper limits of process for good or services that the user can select by the score of the game (specification, page 11, 4th paragraph; page 20, 3rd paragraph). Thus, Wade et al. anticipate the prize information claimed by the applicant.

In response to applicant's arguments against the references individually (Applicant's remarks, page 11, first full paragraph), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Regarding the **applicant's arguments that Tetsuya does not provides specific sites or prizes information in response to different scores of the prescribed game via the network; and further, Tetsuya fails to disclose a management server which automatically provides the game device with different location information specifying the shop server in response to different scores of the prescribed game** (Applicant's remarks, page 11,

first full paragraph), this is deemed to be not persuasive since those limitation have been taught by Wade et al. as presented above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 571-272-4440. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BN


XUAN M. THAI
SUPERVISORY PATENT EXAMINER

TC3700